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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Microbook International, Inc.

Serial No. 76/174,284

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LLC for Microbook International, Inc.

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Before Simms, Bottorff and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

Microbook International, Inc. (applicant) has filed an
application to register the mark INTELLITEXT READER, in
typed form, for goods ultimately identified as "computer
software which converts raw text into a formatted file for
use in eventual downloading into an electronic display
device" in International Class 9.¹

¹ Serial No. 76/174,284 filed on December 1, 2000. The
application is based on an allegation of a bona fide intention to

The examining attorney refused to register applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C.

§ 1052(d), because of the registration of the mark INTELLI-TEXT (in typed form) for "computer software, and printed instruction manual sold therewith, for use in creating customized documentation in the field of human resources management" in International Class 9.²

After the examining attorney made the refusal final, this appeal followed.³

We affirm.

The examining attorney's position is that in applicant's mark INTELLITEXT READER, the dominant portion of the mark is the term "Intellitext," and the dominant portion of both marks is essentially identical, INTELLITEXT and INTELLI-TEXT. While applicant's mark includes the disclaimed word "Reader," when the marks are viewed in their entireties, the examining attorney determined that

use the mark in commerce. In addition, the application has been amended to disclaim of the word "Reader."

² Registration No. 1,960,850 issued March 5, 1996. Affidavits under Sections 8 and 15 have been accepted or acknowledged.

³ In addition to the refusal under § 2(d), the examining attorney also made final her requirement that applicant submit additional information. Applicant has responded that its "product is not yet being marketed and no advertisements or promotional brochures are available. As Applicant's product is very specialized and unique, there are no competitor examples of Applicant's product, either." Amendment received October 25, 2001, p. 4. In view of applicant's response, we reverse the requirement for additional information.

these differences were not enough to avoid the marks being held to be highly similar in sound, appearance, connotation, and commercial impression.

As to the similarities of the goods, the examining attorney observed that both applicant's and registrant's goods are computer software. More importantly, the examining attorney found that the functions of the goods are closely related:

The applicant describes the function of its software as "software which converts raw text into a formatted file for use in eventual downloading into an electronic display device." The registrant[] describes the function of its software as "for use in creating customized documentation in the field of human resources management." Both functions are related. The registrant's software creates customized documents and does not limit that creation. This includes the formatting of documents into a customized format for use in eventual downloading into an electronic display device, such as the applicant describes.

Brief at 5-6.

The examining attorney has also submitted excerpts from publications that indicate that "the same providers of software that can create documents can use the software to convert the document to another text." Brief at 6.

Dictation software, on the other hand, can be used to create documents, since it interprets what you say and converts your speech into computer text.
Chattanooga Times, March 14, 2000.

DocID software does require that the documents first be scanned to create document images and that the

images be then converted to the associated text files via optical character recognition (OCR) processing.
Legal Tech, June 1999.

Trellix 1.0, recently developed by Dan Bricklin, co-creator of VisiCalc for the Apple II in the early 1980s, lets users create documents in various formats that are then converted to HTML and imported into NetObjects TeamFusion.
InfoWorld Daily News, December 8, 1997.

IBM will team up with its Lotus Development Corp. subsidiary to demonstrate how Lotus Notes' management, workflow, document creation, forms, and tabling capabilities can be used to create documents that are then converted on the fly--using InterNotes Publisher--into HTML-based Web pages.
PC Week, October 30, 1995.

The Distiller converts PostScript files to PDF. Exchange creates documents by "printing" them to a disk file in PDF format.
ASAP, March 1994.

When we finish creating the document, the application converts it to an ASCII file and deletes the MiniWord document.
HP Professional, March 1993.

The examining attorney also submitted copies of several registrations to show that entities have obtained registrations for software that includes both document creation and conversion functions. See Registration Nos. 2,520,210; 2,514,087; 2,500,755; and 2,169,419. Because the examining attorney found that the marks were highly similar and the goods were related, the examining attorney refused registration because there was a likelihood of confusion.

Applicant responds by arguing that [p]utting aside Registrant's use of a hyphen between 'INTELLI' and "TEXT,' the Applicant's mark is different due to the use of the term 'READER,' notwithstanding that the term is descriptive and has been disclaimed. The term 'READER' gives the Applicant's mark a different appearance, pronunciation and meaning." Br. at 3.

Regarding the goods, applicant first argues that "likelihood of confusion will not be found, per se, if two similar marks are both, broadly, used on computer software products." Br. at 4 (emphasis omitted). Applicant goes on to assert that its computer program is used in association with so-called "E-books," while registrant's products is used by human resource professionals. "Obviously, these functions are completely unrelated, thus confusion in the marketplace is unlikely." Id. (emphasis omitted). Applicant also maintains that since the goods of both applicant and registrant are specialized, to the extent that there may be overlapping purchasers, "this overlap is so tiny as to be irrelevant." Br. at 6. Therefore, applicant submits that the refusal to register under Section 2(d) should be reversed.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors

set out in In re Majestic Distilling Co., ___ F.3d ___, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

First, we consider whether applicant's and registrant's marks, when compared in their entirety, are similar in sound, appearance, or meaning such that they create similar overall commercial impressions. Here, except for the addition of the descriptive word "reader," the marks are virtually the same. While registrant's mark contains a hyphen, both applicant's and registrant's marks contain the same word "Intellitext." The presence or absence of a hyphen does not change the commercial impression of the marks. The CCPA held that the addition of a hyphen and another digit did not eliminate the similarity of the marks. See Phillips Petroleum Co. v. C.J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) ("The addition of the extra 6 and the hyphen has already

been held not to avoid likelihood of confusion, and in the absence of some other apparent significance for the term 6-66 we find this conclusion inescapable").

Furthermore, the addition of the word "reader" does not change the appearance, pronunciation, meaning, or commercial impression. In a similar case, the Federal Circuit held that the addition of the word "Swing" to registrant's mark "Laser" did not result in the marks being dissimilar. "[B]ecause both marks begin with 'laser,' they have consequent similarities in appearance and pronunciation. Second, the term 'swing' is both common and descriptive... Regarding descriptive terms this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion." Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1845-45 (Fed. Cir. 2000) (citations and quotation marks omitted). See also In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Court held that the addition of "The," "Cafe" and a diamond-shaped design to registrant's DELTA mark still resulted in a likelihood of confusion); Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products).

Thus, while applicant's mark contains the word "Reader," applicant admits that the word is descriptive (Br. at 2) and the articles retrieved from the Nexis database support this admission. See Office action dated April 24, 2001, Attachments. This disclaimed matter is unlikely to significantly change the commercial impression of applicant's mark and distinguish the mark from registrant's. Therefore, we conclude that since the dominant part of both marks is the common word "intellitext," the marks are similar in sound, appearance, meaning, and commercial impression.

Now we will consider whether applicant's and registrant's software are related. There is no rule that considers all software to be related. Electronic Data Systems Corp. v. EDSA Micro Corp., 23 USPQ2d 1460, 1463 (TTAB 1992) ("All computer software programs process data, but it does not necessarily follow that all computer programs are related").

When we consider the relatedness of the goods, we must consider the goods as they are identified in the application and registration. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective

descriptions of goods"). See also Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"). While applicant argues that its "computer program is especially useful when used in association with so-called 'E-books,'" the identification of goods does not limit the goods in this way.

Registrant's software is used to create customized documentation in the field of human resources management while applicant's software converts raw text into a formatted file for use in eventual downloading into an electronic display device. The applicant describes the function of its software as "software which converts raw text into a formatted file for use in eventual downloading into an electronic display device." We agree with the examining attorney's argument that registrant's software creates customized documents and does not limit that creation. The format that this software may create the

documents could include a customized format for use in eventual downloading into an electronic display device. We note that "[a]pplicant freely admits that if the Registration covered that function [converting the customized document into a downloadable format for downloading into an electronic display device], Applicant's mark would not be registrable." Br. at 5. The fact that registrant's software may not actually have this feature does not mean that the software as described in the registration's identification of goods is not related to applicant's software. As the examining attorney's evidence shows, computer software that both creates documents and converts the text is not unusual. Furthermore, there is no limitation on applicant's identification of goods that would exclude its use in the human resources field. Therefore, purchasers of software for human resources management to use in creating customized documentation would likely also include purchasers of software that converts text into a format for downloading into an electronic display device. Thus, we conclude that the purchasers of both registrant's and applicant's software would be similar.

Applicant also argues that registrant's computer programs are specialized and expensive. There is no

evidence that would indicate that registrant's programs, priced at \$995, are considered expensive for professional software. Inasmuch as applicant's software is not limited to any particular field, there is no reason to find that applicant's software would not be found in the same specialized field as registrant.

Finally, if we had any doubts regarding whether there is a likelihood of confusion, we resolve them in favor of the prior registrant and against the newcomer. Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992).

Decision: The refusal to register on the ground that applicant's mark is confusingly similar to the mark in the cited registration is affirmed.